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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,549	04/08/2004	Steven R. Cosentino	DTG-105US	8365
31344	7590	06/08/2006	EXAMINER	
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WILMINGTON, DE 19899			PAPER NUMBER	

1771

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/820,549

**Applicant(s)**

COSENTINO ET AL.

**Examiner**

Lynda M. Salvatore

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's remarks filed 3/23/06 have been fully considered and entered. Applicant's arguments with respect to obviousness rejections made over Benim et al., US 20030003249 A1 as set forth section 5 are found persuasive. As such, this rejection is withdrawn. However, upon further consideration, the following new ground of rejection is set forth herein below.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Applicant argues that present claims are not encompassed by the subject matter presented in the copending applications below on the grounds that the limitation of "said multi-layer structure forms said bag" is not claimed. This argument is not found persuasive. It is the position of the Examiner that the structural and/or chemical features of the multi-layer structure are fully encompassed by the copending applications set forth below. The mere recitation of "forms a bag" does not sufficiently evidence that the claimed multi-layer structure is not an obvious variant of the multi-layer structures set forth in the copending applications below. Since, Applicant has not provided any definite limitations as to the structure of the bag, it is the position

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of the Examiner that the limitation of “said multi-layer structure forms said bag” constitutes an intended use and it would be obvious to form a bag from any of the multi-layer structures set forth in the copending applications below.

3. Claims 1-16 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No.10/714144. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter sought in the instant application is fully encompassed by the subject matter of 10/714144.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-16 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No.10/718334. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter sought in the instant application is fully encompassed by the subject matter of 10/718334.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-16 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No.10/300352. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter sought in the instant application is fully encompassed by the subject matter of 10/718334.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 2 is indefinite because it is not clear which polymeric layer Applicant is referring (e.g., polymer film layer or scrim polymer layer).

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-3, 8-11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benim et al., US 20030003249 A1 in view of Vander Velden et al., US 5,494,745.

The published US patent application issued to Benim et al., teach a label stock comprising a facing of a first film layer (13), and a lower melting heat sealable second layer (14). Said facing material is further laminated to an insulating fibrous batt (30) (abstract, Figure 2, Section 0022 and 0026). Suitable facing film materials include bi-axially oriented polyester film (Section 0028).

With regard to the reinforcing polymer scrim limitations, Benim teach as an alternative to the fibrous batt (30), a variety of suitable fibrous materials such as those made from melt-blown

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polyolefins, non-woven, felt or needled fabrics (Section 0022-0025). Benim et al., does not specifically teach the structure of a scrim, however, the patent issued to Vander Velden et al., teach a multi-layer laminated structure comprising a multi-layer oriented film adhesively laminated to a polypropylene reinforcing scrim (title, abstract, column 2, 50-65, column 5, 25-40). Said multi-layer is used to label stock (column 7, 5-32).

Therefore, motivated by the desire to provide a reinforced label stock it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the fibrous materials taught by Benim et al., with the polymeric reinforcing scrim taught by Vander Velden et al.

With specific regard to the recitation of “consisting essentially of”, the burden of establishing that any composition components of the prior art references applied by the Examiner is excluded from the claims as argues appropriately rests with Applicant’s. *In Herz*, 190 USPQ 461 (1976) and *Ex parte Hoffman*, 12 USPQ 2d 1061 (1989). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355

With regard to claim 2, Benim et al., teach a film having a thickness ranging from .0025 mil to 5 mil. For example 1 mil converts to .001 inches (Section 0054).

With regard to claim 3, Benim et al., teach laminating the fiber insulating material between film, paper and/or fabric layers (abstract, figure 1 and section 0025).

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With regard to claims 8-11, Benim et al., teach providing first layer (13 or 22) and another second sealing layer (14 or 24). Benim et al., teach that under heat and pressure, heat sealing layer (24) softens and adheres to the fibrous material (Section 0025-0027). Suitable first layer materials include polyethylene film or bi-axially oriented polyester film (Section 0025-0028). Suitable second layer materials include a co-polyester resin (Section 0028). Said layers are co-extruded to form a single film (section 0025-0027).

With regard to the low-density polyethylene limitation, Benim et al., does not specifically teach the density of the polyethylene, however, it is the position of the Examiner that it would be obvious to one having ordinary skill in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416

With regard to providing a polyethylene film as recited in claim 10 and a bi-axially oriented polypropylene film as recited in claim 11, Benim et al., teach that the film can be made from polyester, polyethylene or polypropylene. Though, Benim et al., only exemplifies a bi-axially oriented polyester film, it is reasonable to presume that based on the disclosure of said other film forming thermoplastics, a polypropylene film could also be bi-axially oriented.

With regard to the recycling limitations, Benim et al., teach that the packaging composite is wholly recyclable (Section 0010).

With regard to the limitations of providing a thermal bonding polymer layer having a thickness between 10% and 40% of the combined thickness of the film and thermal bonding layer, Benim et al., does not specifically teach the relative ratio between the film layer and the bonding layer, however, it is the position of the Examiner that it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the relative

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thicknesses of each layer based on the desired end use as a packaging label and/or self sealing material (Sections 0035 and 0036). It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233

With regard the recitation directed to a bag, it is the position of the Examiner that since the prior art presently meets all of the structural and chemical features set forth there is nothing on record to suggest that the article of Benim et al., could not function as bag. Absent any further distinguishing structural limitations directed to said bag, said recitation is treated as intended use.

#### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M. Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

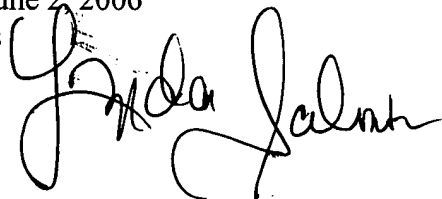


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 2, 2006

ls

A handwritten signature in black ink, appearing to read "J. A. Salazar", written over the "ls" text.